



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/886,289	06/22/2001	Paolo Burattin	022701-935	6557

7590

07/31/2003

Norman H. Stepno, Esquire
BURNS, DOANE, SWECKER & MATHIS, L.L.P.
P.O. Box 1404
Alexandria, VA 22313-1404

EXAMINER

PASTERCZYK, JAMES W

ART UNIT

PAPER NUMBER

1755

DATE MAILED: 07/31/2003

5

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/886,289

Applicant(s)
Burattin et al.

Examiner
J. Pasterczyk

Art Unit
1755



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Jun 22, 2001
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 4 6) ☐ Other: _____

Art Unit: 1755

1. This Office action is in response to the IDS filed 6/22/01.

2. Claims 1-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, 1. 2-3, change “which comprises” to --said process comprising-- to make clear what the object of the clause is; at the end of step (a) insert --to form a mixture-- to give step (b)’s “to the mixture thus formed” antecedent basis; in step (c) “the nickel values” strictly lack antecedent basis, plus this language is more of a metallurgical ore reduction process than a more definite chemical process since only Ni-OH is specifically present at this point; in step (d) “said nickel values having an oxidation state of greater than zero” also lacks antecedent basis.

In claims 2 and 3 insert --in step (c)-- after “stirring”.

In claim 4 “the mixture of reaction” lacks antecedent basis and is ungrammatical.

In claims 5 and 6, it is not clear if the step (b) recited is now an additional step or instead an additional limitation on the step (b) already present. In claim 6 it is not clear versus what the stoichiometric excess is to be measured.

In claims 7 and 8, change “the amount . . . ranging” to --wherein the amount . . . ranges--.

In claims 9-11, it is not clear if the step (d) recited is an additional step compared to the step (d) already present or an additional limitation on the step (d) already recited. It appears to be a method of carrying out the recited limitation of step (d).

Art Unit: 1755

In claim 12, l. 1, insert --wherein-- before "said"; in l. 2 change "having" to --has--; in the formula, top right, the close paren should be after M, and the coefficients m1 and m2 should be subscripted in the manner of m3. In the first two lines after the formula change "may be" to --are-- for definiteness. On the next page, the 0 in N02 looks like a zero instead of the letter "O"; in the next line and lines 7, 10 and 11, change "may be" to --are--; in l. 9 "other metal cations" is omnibus.

In claim 13, l. 1, insert --wherein-- before "said"; in l. 2 change "having" to --has--.

In claim 14, l. 1 insert --wherein-- before "said"; in l. 2 change "having" to --has-- and insert --or (III)-- after "(II)"; in labeled l. 5 change "may be" to --are--; in the next line delete "such"; in l. 9 change "among" to --the group consisting of-- for clear closed Markush language; lines 10-14 appear to be duplicative and prolix with lines 14-20, thus it is not clear if the two sections refer to different entities; nevertheless, the ammonium cations should not have a hyphen before them but instead should have a positive charge superscripted after them; l. 11, 14 and 21 should change "may be" to --are--; in l. 12 and 22 "other cations" is omnibus language; in l. 19 change "among" to --the group consisting of--; "wherein the radicals R" of l. 21 et seq. is not clearly different from the same recitation of l. 24 et seq. On the following page, l. 7, change "among" to --the group consisting of--; in l. 9, 12 and 13, the ammonium cation should have no hyphen but instead a superscripted positive charge, and "may be" should be --are--; again "wherein the radicals" appears to have duplicative recitation beginning at l. 9 and 12, and "other metal cations" is omnibus. In l. 15 delete "or having the structural formula (III):" and change it to

Art Unit: 1755

a semicolon. In l. 20 delete "valency", in l. 21 insert "--between the two P atoms" after "bond", change "hydrocarbonaceous" to --hydrocarbyl--, and change "deriving" to --derived--; in l. 23 change "these various cyclic radicals" to --said heterocyclic radical--.

In claim 15, l. 1, insert --wherein-- before "said", and in l. 2 change "comprising" to --comprises--.

In claim 16, l. 1, change "The" to --A--, and in l. 2 insert --wherein said catalyst is-- after "nickel values"; again "nickel values" sounds more like a metallurgical term for ore reduction methods than to methods of making catalysts.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Huser et al., USP 5,908,805 (hereafter referred to as Huser).

Huser discloses the invention substantially as claimed (abstract; col. 1, l. 52 to col. 2, l. 53; col. 3, l. 10-65; col. 4, l. 16-43; col. 5, l. 49-64; examples 1-10, 18-20).

Huser lacks that the addition of hydrogen cyanide is a separate, distinct step.

Art Unit: 1755

However, since Huser discloses that addition of nitriles is a step in the process of use of the catalyst, one of ordinary skill in the art would have had to choose when, in a short process, to add such a reagent which is a precursor to cyanide ion.

It would have been obvious to one of ordinary skill in the art to apply that skill to the disclosure of Huser with a reasonable expectation of obtaining a highly-useful method of making a hydrocyanation catalyst and the catalyst itself with the expected benefit of the catalyst being easily regenerated.

5. Claims 1-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kuntz, USP 4,087,452 (hereafter referred to as Kuntz).

Kuntz discloses the invention substantially as claimed (abstract; col. 2, l. 17 to col. 3, l. 6; col. 3, l. 44 to col. 4, l. 45; col. 5, l. 25-33; col. 6, l. 12-34; examples).

Kuntz lacks disclosure of the particular order of addition presently claimed.

However, it would have been within the skill of the routineer in the art to change the order of addition of the same reagents used in Kuntz as those used in the present invention to achieve the order of addition of the present invention.


It would have been obvious to one of ordinary skill in the art to apply that skill to the disclosure of Kuntz with a reasonable expectation of obtaining a highly-useful hydrocyanation catalyst and method of making it with the expected benefit of the catalyst being more easily separable from the product made using it.

Art Unit: 1755

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to J. Pasterczyk whose telephone number is (703) 308-3497. The examiner can normally be reached on M-F from 9 to 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Bell, can be reached on (703) 308-3823. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9310 for normal faxes, 872-9311 for after final faxes.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.


Mark L. Bell
Supervisory Patent Examiner
Technology Center 1700



J. Pasterczyk

AU 1755

7/25/03